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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/859,576	06/15/2001	Shinya Kadono	HYAE:077A	4313

7590 06/03/2005

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EXAMINER

CALLAHAN, PAUL E

ART UNIT PAPER NUMBER

2137

DATE MAILED: 06/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/859,576

Applicant(s)

KADONO, SHINYA

Examiner

Paul Callahan

Art Unit

2137

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 May 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8, 11-14, 35 and 36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 2 and 4 is/are allowed.
- 6) ☐ Claim(s) 1, 3, 5-8, 11-14, 35 and 36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 May 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. Claims 1-36 were originally pending in this application. The claims have been made subject to a restriction requirement in which the Applicant has elected with traverse the group represented by claims 1-8, 11-14, 35, and 36. Therefore these claims are the ones that remain pending in this application and have been examined.

Election/Restrictions

2. Applicant's election with traverse of group I consisting of claims 1-8, 11-14, 35, and 36 in the reply filed on 3-17-2005 is acknowledged. The traversal is on the ground(s) that the groups delineated by the Examiner are so closely related that no burden exists in examining them jointly. This is not found persuasive because the inventions embodied in each group are separate and distinct and are not disclosed as being useful together. As evidence of this, the groups would be classified in different class / subclasses, disclose different methods of embedding data, and embed different types of data in a manner not useful together. A substantial burden would exist in the examination of what are in essence two very different methods of watermarking image data. The requirement is still deemed proper and is therefore made FINAL.

Priority

3. Acknowledgment is made of applicant's claim for foreign priority based on an application filed in Japan on 7-3-1997. It is noted, however, that applicant has not filed a certified copy of the Japanese application as required by 35 U.S.C. 119(b).

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

5. Claims 7 and 8 are rejected under 35 U.S.C. 102(a) as being clearly anticipated by Tewfik et al. US 6,226,387.

As for claim 7, Tewfik teaches a method for embedding secret information in a prescribed position in an image signal, wherein the position where said secret information is to be embedded is varied frame-by-frame (col. 4 lines 18-35).

As for claim 8, Tewfik teaches a method for extracting secret information from an image signal in which said secret information is embedded by an information embedding method according to Claim 7, wherein: when said secret information is extracted from said image signal, the position from which said secret information is extracted is varied frame-by-frame (col. 4 lines 18-35, col. 7 lines 8-40).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1, 3, 5, 6, 11-14, 35, and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tewfik et al., US 6,226,387, in view of Rhoads, US 5,636,292.

As for claims 1, 5, and 13, Tewfik teaches a method for embedding secret information in a color image signal, comprising the steps embedding said secret information in a prescribed position in a first signal component of said color image signal; and embedding information, which specifies the position where the secret information is embedded, in a second signal component of said color image signal. (Abstract, col. 4 lines 18-35). However Tewfik does not explicitly teach that the watermark data embedded in the second signal component is position data related to the first watermark. Rhoads does teach this feature (col. 16 lines 15-30). Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate this feature into the teachings of Tewfik. It would have been desirable to do so as this would allow for more rapid detection of the watermark data.

As for claims 3, 6, and 14, Rhoads teaches a method for extracting secret information from a color image signal comprising the steps of: extracting said position information from said second signal component basis extracting said secret information component of said color image signal from said first signal (col. 16 lines 5-30).

As for claims 11 and 12, these claims represent the apparatus carrying out the method of claims 1 and 5 and are thereby rejected on the same basis as are those claims.

As for claims 35 and 36, these represent the computer program product, embodied in a memory medium, that when read out cause the apparatus of claims 11 and 12 to carry out the method of claims 1 and 5. Therefore they are rejected on the same basis as are those claims.

Allowable Subject Matter

8. Claims 2 and 4 are allowed.

Conclusion

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul E. Callahan whose telephone number is (571) 272-3869. The examiner can normally be reached on M-F from 9 to 5.

If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, Andrew Caldwell, can be reached on (571) 272-3868. The fax phone number for the organization where this application or proceeding is assigned is: (703) 872-9306. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

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Paul Callahan